DOCKET NO: 215760US2

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF	:
GREGORY WRIGHT	: EXAMINER: BRINCH, S.
SERIAL NO: 09/986,384	:
FILED: NOVEMBER 8, 2001	: GROUP ART UNIT: 2625
FOR: METHOD AND SYSTEM OF REMOTE MONITORING OF IMAGE FORMING APPARATUS	:

REMARKS ACCOMPANYING REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

Applicants respectfully request that a Pre-Appeal Brief Conference be initiated in accordance with the pilot program outlined in the Official Gazette Notice of July 12, 2005.

FAILURE TO PRESENT A *PRIMA FACIE* CASE OF ANTICIPATION OR OBVIOUSNESS

The Official Action of March 28, 2006 and the Advisory Action of July 11, 2006 have failed to provide a *prima facie* case of anticipation under 35 U.S.C. § 102 or obviousness under 35 U.S.C. § 103 with respect to any of Claims 1-18. In the Official Action of March 28, 2006, Claims 1, 3-7, 9-13, and 15-18 were rejected under 35 U.S.C. § 102(b) as being anticipated by Hitachi Koki Imaging Solutions, Inc. document entitled "The Internet Docket Controller" dated October 2000 (hereinafter Hitachi); and Claims 2, 8 and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hitachi.

Briefly recapitulating, Claim 1 is directed to a method of monitoring an image forming apparatus. The method includes: a) receiving, at a location which is remote from the

image forming apparatus, first parameters representing a condition of at least one part of the image forming apparatus; b) storing the first parameters; and c) receiving, at the location which is remote from the image forming apparatus, second parameters after at least one image forming operation is executed by the image forming apparatus. The second parameters represent the condition of the at least one part of the image forming apparatus related to at least one of the first parameters. The method also includes d) comparing, at the location which is remote from the image forming apparatus, the received first parameters and second parameters; and e) controlling a display of the condition on a terminal that is remote from the image forming apparatus using a result of the comparing step. Applicants' claimed invention allows for improved remote control over printing resources.

Hitachi describes Internet-enabled copiers and printers which allow access to product information, device configuration, local and remote printing, finishing, service and support from a standard web browser. Hitachi further describes *i-copiers* and *i-printers* which incorporate Hitachi's Internet Document Controller™ (*i*Doc) architecture for device control and monitoring via web-based device management software. The Hitachi architecture includes printer emulations which facilitate document reproduction for users working in a variety of software or hardware environments (e.g., PCL 5e, PCL 6 and TIFF, with Adobe® PostScript® 3). The Hitachi architecture enables a single printer to offer up to 64 print services, or "virtual printers," each of which can be individually configured to address environments that do not rely on print drivers, such as Unix.

Hitachi also describes an *i-billing* module used to calculate usage information, apply the usage information to a service plan and print a monthly invoice. From an embedded web page a consumer and a dealer can see actual toner usage on a job-by-job basis, or on a monthly or quarterly timeframe. The *i-copier/printer* is able to adjust a monthly invoice

based on actual toner usage above or below a contracted allowance. Hitachi also describes an ability to email monthly "click counts" for copy and print jobs.

Hitachi describes an *i-print* module for printing/distributing documents locally, remotely and globally via one of four printing methods. The four methods are:

- **network printing** to a single print engine on a local network;
- **broadcast printing** to multiple engines of the same or different types on a network;
- **printing** to a single printer anywhere in the world, using the IPP protocol; and
- **broadcast printing** to multiple local and remote engines, over a network and/or the Internet using the IPP protocol.

Hitachi also describes bi-directional print drivers having a graphical user interface and two-way communication with a printer or copier. The driver-integrated Printer Monitor is a Windows-based utility that displays a printer's capabilities and status so a user can know available media types and sizes and printer setup before printing. The Printer Monitor window displays the messages shown on the copier/printer's Operator Control Panel, a list of outstanding jobs, printer status that might affect a print job, such as Printer Offline or Door Open, and provides automatic event notification such as Toner Low or Paper Out. Every user on the network can individually configure the Printer Monitor for the specific events they want to be notified about and the way they want to be notified – via pop-up message, beep or other sound. The Printer Monitor can tell a user when the last page of a job has printed.

Hitachi also describes an *i-service* module which enables technicians, using a standard web browser, to access service documentation, remotely configure a copier/printer and run remote diagnostics for subsystem components via the Internet or a modem. Service logs for accounting data such as clock counts, events like Toner Low, and copier/printer errors, can be downloaded on demand or emailed at specified times. The Hitachi *i-service* module allows a remotely located technician to access a machine and make a number of electromechanical adjustments. The Hitachi *i-service* module allows a remotely located technician to program

the copier/printer to send error reports and early warning notifications for preventative maintenance and consumables replenishment by email or page without user interaction.

However, as acknowledged in the Official Action, Hitachi does not disclose or suggest comparing first and second parameters as recited in Applicants' originally filed independent claims. Nonetheless, the Official Action asserts that comparing first and second parameters as recited in Applicants' originally filed independent claims is inherent in Hitachi in view of a hypothetical created in the Official Action.

Applicants submit that the assertion of inherency is insufficient to show that Hitachi inherently teaches the originally claimed comparing because the rejection fails to show "that the alleged inherent characteristic necessarily flows from the teachings of the applied prior art"[1] The Official Action provides inadequate rationale for this finding of inherency. "The fact that a certain result may occur or be present in the prior art is not sufficient to establish inherency of that result or characteristic."[2] "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'"[3]

Further, independent Claims 1 and 7 recite "comparing, at the location which is remote from the image forming apparatus, the received first parameters and second parameters." Nothing in Hitachi discloses or suggests "comparing, at the location which is

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[1]See MPEP 2112 (emphasis in original) (citation omitted). See also same section stating that "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic," (emphasis in original). See also In re Robertson, 49 USPQ2d 1949, 1951 (Fed. Cir. 1999) ("[t]o establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill,'" citing Continental Can Co. v. Monsanto Co., 948 F2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991); and "[i]nherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient," Id. at 1269 (citation omitted)).
[2] *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1995, 1957 (Fed. Cir. 1993).
[3] *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

remote from the image forming apparatus, the received first parameters and second parameters."

Furthermore, Applicants submit the hypothetical included in the Official Action does not require or suggest "comparing, at the location which is remote from the image forming apparatus, the received first parameters and second parameters." The Official Action asserts that Hitachi discloses the use of remote diagnostics.[4] Applicants concur. However, this is ***not*** a disclosure of "comparing, at the location which is remote from the image forming apparatus, the received first parameters and second parameters." Instead, Hitachi merely discloses receipt/use of diagnostics, not generating the diagnostics (i.e., not comparing) remotely.

The rebuttal of Applicants' arguments found in the Advisory Action of July 11, 2006 includes further assertions of inherency which are insufficient as they are based on mere conjecture. The Advisory Action also incorrectly characterizes the remote diagnostic function of the Hitachi *i-service* module as the cited control function does not include Applicants' claimed comparing.

CONCLUSION

Based on the above-noted deficiencies in the outstanding rejections, Applicants respectfully request that those rejections be withdrawn or properly supported.

Respectfully submitted,

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[4] Official Action, page 7, lines 3-8.